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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-------------------------|---------------------|------------------|
| 10/754,792 | 01/08/2004 | Alexander Y. Narodetsky | 6890-101 | 8591 |
| 36412 | 7590 | 06/08/2006 | EXAMINER | |
| DUCKOR SPRADLING METZGER 401 WEST A STREET, SUITE 2400 SAN DIEGO, CA 92101-7915 | | | GART, MATTHEW S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3625 | |

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/754,792 | Applicant(s) NARODETSKY, ALEXANDER Y. | |
| | Examiner Matthew S. Gart | Art Unit 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-8 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-8 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History Summary

- Claims 1, 4-8 and 11-14 remain pending in the instant application.
- Claims 2, 3, 9 and 10 have been previously cancelled without prejudice.
- Claims 1, 5, 8 and 12 have been amended per the Applicant's response filed on 4/18/2006.

Drawings

The drawings filed on 4/18/2006 must be corrected per the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948. The correction will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 5-8 and 12-14 are rejected under 35 U.S.C. 112, first paragraph.

Referring to claims 1, 5-8, and 12-14. Claims 1, 5-8 and 12-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere in the specification as originally filed is there support for a "first unpaid user" and a "second unpaid user."

Referring to claims 1, 5-8, and 12-14. Claims 1, 5-8 and 12-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Nowhere in the specification as originally filed is there enablement for a "first unpaid user" and a "second unpaid user."

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 14 are rejected under 35 U.S.C. 112, second paragraph.

Referring to claim 7. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 recites the limitation “first user” and “other users.” There is insufficient antecedent basis for this limitation in the claim. The examiner is unclear if the “first user” is meant to reference the “first unpaid user” of claim 1, and if the “other user” is meant to reference the “second unpaid user” of claim 1.

Referring to claim 14. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 recites the limitation “first user” and “other users.” There is insufficient antecedent basis for this limitation in the claim. The examiner is unclear if the “first user” is meant to reference the “first unpaid user” of claim 8, and if the “other user” is meant to reference the “second unpaid user” of claim 8.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 5-8 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by www.one-and-only.com (hereinafter “One-and-only”).

Referring to claim 1. One-and-only discloses a method of providing a match between users, comprising:

- Receiving and storing user information from a first unpaid user (One-and-only: page 1, “Place a free ad”);
- Providing the user information to a second unpaid user (One-and-only: page 3, “Welcome to One and Only Internet Personals, the only site on the Web that can change your life forever. You get so much for so little. We recommend you start by browsing the ads – for free. Then place your own ad – for free. Then sign up for the Agent of Love so that we can e-mail you with new ads (it’s free, too). Wow, what a wonderful Web!”);
- Receiving a request to contact the first unpaid user for a desired match from the second unpaid user (one-and-only: page 4, “The AGENT OF LOVE will scan all incoming ads daily and e-mail you all the ones that match your preferences. It’s easy, it’s fast and it’s free!”);

- Sending a message to the first unpaid user to notify the first unpaid user of the request by the second unpaid user, the message requesting a payment from the first unpaid user to receive contact identification information of the second unpaid user (one-and-only: page 12, "How to respond to ads"); and
- Sending contact identification information to the first user in response to the payment being made (one-and-only: page 12, "How to respond to ads"),
- Wherein the first user does not receive the contact information of the second user without making the payment and communication between the first user and the second user is not enabled (one-and-only: page 12, "You can respond to ads only if you are an AYCE club member.").

The Examiner notes, one-and-only discloses a method wherein a message (i.e. ad response) is placed by a second user and forwarded to a first user. This message (i.e. ad response) indirectly requests a payment from the first user, because the first user can only respond to the message if he/she is a paying AYCE club member. Once the first user receives the message he/she can become an AYCE member from the ad page (One-and-only: page 12). As a member of the AYCE club, the user can respond to as many messages as he/she wishes.

Referring to claim 5. One-and-only further discloses a method wherein the contact identification information includes personal contact identification information (One-and-only: page 4, "My e-mail address is:").

Referring to claim 6. One-and-only further discloses a method including receiving information via a network (One-and-only: page 3).

Referring to claim 7. One-and-only further discloses a method including in response to the receiving a request includes sending a message to the first user that one or more other users have desired a match, and providing a message for such interest in a list for the first user (One-and-only: page 4, "Agent of Love").

Referring to claims 8 and 12-14. Claims 8 and 12-14 are rejected under the same rationale as set forth above in claims 1 and 5-8.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over www.one-and-only.com (hereinafter "One-and-only").

Referring to claims 4 and 11. One-and-only discloses a method according to claim 1 and a system according to claim 8 as indicated supra. One-and-only further discloses a method and system wherein the user information includes personal identification information (One-and-only: page 4). One-and-only does not expressly disclose a method or system wherein the user information includes article identification information. However these differences are only found in the nonfunctional information stored via the method and system. The type of identification information is not functionally related to the substrate of the method and system. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any type of identification information in the

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fields as shown in one-and-only because such information does not functionally relate to the substrate of the method and system and merely labeling the identification information differently from that in the prior art would have been obvious. See Gulack cited above.

Response to Arguments

Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"Date expectations Technology and enterprise blaze a new trail to your soul mate", Douglas Trattner, Special to the Plain Dealer, The Plain Dealer, Cleveland, Ohio, February 14, 2003, pg. 16, discloses a comparison between online matchmaking services.

Dahod et al., US 6,574,608 B1, June 3, 2003, discloses a web-based system for connecting buyers and sellers.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-273-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MSG
Primary Examiner
June 1, 2006